

REMARKS

The Official Action mailed March 24, 2005, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on July 19, 2000, and January 5, 2005.

Claims 1-22, 29-34 and 38-61 were pending in the present application prior to the above amendment. Independent claims 38-43 have been amended to better recite the features of the present invention, and new claims 62-67 have been added to recite additional protection to which the Applicants are entitled. The Applicants note with appreciation the allowance of claims 10, 11, 21 and 22 (page 11, Paper No. 20050316). Claims 1-9, 12-20 and 29-34 have been withdrawn from consideration by the Examiner (page 2, Id.). Accordingly, claims 10, 11, 21, 22 and 38-67 are currently elected, of which claims 10, 21 and 38-43 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 38, 40-44, 50, 52, 54, 56 and 58-61 as anticipated by U.S. Patent No. 5,812,109 to Kaifu et al. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended. The Official Action asserts that "Kaifu discloses an embodiment (col. 14, line 53 through

col. 17, line 13) that is explained in part by Figures 3, 4A, and 4B, (col. 5, line 26 through col. 14, line 52) wherein an integral image recognition/display apparatus comprises: a plurality of pixel portions ... each having an active device, T11 ... and each having a pixel electrode ... over an active matrix substrate, 1; and a plurality of sensor portions S11 ... over said active matrix substrate, wherein said sensor portion includes a photo-electric conversion device, 4 ...” (pages 3-4, Paper No. 20050316).

In response, independent claims 38-43 have been amended to recite a source signal line side driving circuit, a gate signal line side driving circuit and a driving circuit for controlling sensor portions. Claims 38, 39, 41 and 42 have also been amended to remove features which are not believed to be critical to the patentability of the claims. In the amended claims, sensor portions are controlled by a driving circuit, which is different from two driving circuits for pixel portions. In other words, the amended claims comprise three driving circuits. On the other hand, Kaifu discloses that the liquid crystal display element and the upper electrode D of the photoelectric conversion element corresponding to one pixel are connected to the same switch element (Kaifu at column 5, lines 35-46; and Figure 3). Kaifu does not teach a driving circuit other than a source signal line side driving circuit and a gate signal line side driving circuit. Therefore, Kaifu does not teach a source signal line side driving circuit, a gate signal line side driving circuit and a driving circuit for controlling sensor portions, either explicitly or inherently.

Since Kaifu does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 3 of the Official Action rejects claims 39, 45-49, 51, 53, 55 and 57 as obvious based on the combination of Kaifu and U.S. Patent No. 5,585,817 to Itoh et al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Kaifu. Itoh does not cure the deficiencies in Kaifu. The Official Action relies on Itoh to allegedly teach "a plurality of sensor portions, 109, disposed in matrix over an opposed substrate, 106, constituting a display panel, wherein said sensor portion has a photo-electric conversion device" (page 8, Paper No. 20050316). However, Kaifu and Itoh, either alone or in combination, do not teach or suggest a source signal line side driving circuit, a gate signal line side driving circuit and a driving circuit for controlling sensor portions.

Since Kaifu and Itoh do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 62-67 have been added to recite additional protection to which the Applicants are entitled. For the reasons stated above and already of record, the Applicants respectfully submit that new claims 62-67 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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